



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,335	02/14/2002	Yvonne Watters Booth	AUS920010775US1	1983

45502 7590 04/21/2006

DILLON & YUDELL LLP  
8911 N. CAPITAL OF TEXAS HWY.,  
SUITE 2110  
AUSTIN, TX 78759

EXAMINER

APPIAH, CHARLES NANA

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/076,335	<b>Applicant(s)</b> BOOTH ET AL.	
	<b>Examiner</b> Charles N. Appiah	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9, 11, 12, 21, 23-27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 11, 12, 21, 23-27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on February 02, 2006 have been fully considered but they are not persuasive. In response to Applicants' argument that "once separated according to Grube's teaching, the proximity card and communication unit have no communication to intercept", examiner maintains that, contrary to applicants' assertion, the physical separation between the card and the communication unit leads to either the proximity card either not transmitting an appropriate response in the form of the proximity message (see col. 3, lines 22-40) meets the transmission of "data of said communication between the electronic device and the second network element " to be intercepted by the central controller. Therefore the rejection using Grube is not in error as alleged by Applicant and the rejections using Grube et al meets the limitations of the claims as amended and are therefore maintained.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-5, 7-9, 21 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it is not clear how the feature of "distributing a tracing tool to a first network element within the wide area network" is linked to "monitoring traffic on ....., "intercepting data of said communication between said electronic device and the second network element ..."

With respect to claim 9, the recitation of the limitation "said data processing" on line 9 lacks prior and proper antecedent basis in the claim.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3, 7-9, 11, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by **Grube et al. (5,638,423)**.

Regarding claims 1, 9 and 24 Grube discloses a method, a system for determining an electronic device within a wide area network, and a machine readable medium having a plurality of instructions when executed cause the machine to perform a method for determining a position of an electronic device within a wide area network, the method comprising: distributing a tracing tool to a first network element within the wide area network (provision of proximity user card with the communication unit, see col. 1, lines 55-57), detecting a physical separation of the electronic device and an associated user (message being sent to the central controller when the distance between the proximity card and the communication unit exceeds a predetermined value, col. 1, lines 59-64), determining identifying indicia of the electronic device, wherein the identifying indicia are automatically transmitted the electronic device during communication between the electronic device and a second network element of the wide area network (proximity card transmitting user identification over a second RF communication path to the communication unit, col. 1, lines 57-59), monitoring traffic on the wide area network utilizing the tracing tool wherein the monitoring comprises

intercepting data of the communication between the electronic device and the second network element including the identifying indicia in response to the physical separation (proximity message being set when a response is not received from proximity card and sent to central controller, see col. 3, lines 26-48), and determining a physical position of the electronic device within the wide area network in response to an interception of the identifying indicia (central controller determining the location of the communication unit, such that the unit may be reclaimed and the person in possession apprehended, see col. 3, lines 48-54).

Regarding claims 3, 11 and 26, Grube further discloses wherein determining the identifying indicia of the electronic device comprises: identifying data transmitted by the electronic device prior to the physical separation utilizing a portion of the wide area network, and by extracting the identifying indicia from data transmitted by the electronic device prior to the physical separation (see col. 2, lines 39-55).

Regarding claim 7, Grube further discloses the method comprises causing data specifying the identifying indicia to be stored within a database associated with the first network element prior to the physical separation (see col. 2, lines 12-27), and determining the identifying indicia of the electronic device comprises determining the identifying indicia utilizing the database (see col. 2, line 62 to col. 3, line 10).

Regarding claim 8, Grube further discloses generating a notification indicating the physical position of the electronic device for a responsible party associated with the electronic device (system manager being informed by central controller of the proximity message, col. 3, lines 38-45).

5. Claims 2, 4, 5, 12, 21, 23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Grube et al.** as applied to claims 1, 9 and 24 above, and further in view of **Cotichini et al. (6,300,863)**.

Regarding claims 2, 21, 23 and 25, Grube fails to explicitly teach the distributing further comprises distributing the tracing tool to a plurality of network elements within the wide area network the elements being a plurality of IP routers within the wide area network and the monitoring server is distributed among a plurality of network elements within the wide area network.

Cotichini discloses a method for monitoring and locating an electronic device over a global network in which IP routers and a monitoring server are used in monitoring for lost, stolen or missing electronic devices (see Fig. 1, col. 8, lines 12 and col. 16, lines 65).

It would therefore have been obvious to one of ordinary skill in the art to combine Cotichini's monitoring system with Grube unauthorized access prevention system in order to locate a wide variety of missing or lost electronic devices such as portable computers, PDAs, PCs and cellular telephones as taught by Cotichini (see col. 2, lines 26-34).

Regarding claims 4, 12, and 27, Grube fails to explicitly teach wherein determining the identifying indicia of the electronic device comprises determining a MAC address of the electronic device.

In an analogous field of endeavor, Cotichini discloses a method for monitoring and locating an electronic device over a global network in which the indicia, which is

the MAC, address of the electronic device is used in identifying the electronic device (see col. 16, lines 37-42).

It would therefore have been obvious to one of ordinary skill in the art to combine Cotichini's monitoring system with Grube unauthorized access prevention system in order to locate a wide variety of missing or lost electronic devices such as portable computers, PDAs, PCs and cellular telephones as taught by Cotichini (see col. 2, lines 26-34).

Regarding claim 5, Grube fail to disclose that determining the identifying indicia of the electronic device comprises determining the identifying indicia utilizing at least one of host name and an IP address within data transmitted by the electronic device prior to the physical separation utilizing a portion of the wide area network.

Cotichini further discloses wherein the identifying indicia is determined by utilizing host name or IP address of the electronic device contained within data transmitted by the electronic device prior to the physical separation utilizing a portion of the wide area network (see col. 11, lines 51-64).

It would therefore have been obvious to one of ordinary skill in the art to combine Cotichini's monitoring system with Grube's unauthorized access prevention system in order to locate a wide variety of missing or lost electronic devices such as portable computers, PDAs, PCs and cellular telephones as taught by Cotichini (see col. 2, lines 26-34).

6. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Grube et al** as applied to claims 1 and 24 above, and further in view of **Gould et al. (6,756,917)**.

Regarding claims 29 and 30, Grube fails to explicitly teach wherein determining the physical position of the electronic device comprises transmitting a link tracing message between the electronic device and the first network element, identifying a network element coupled between the electronic device and the first network element in response to a transmission of the link tracing message, and determining the physical position of the electronic device utilizing the network element coupled between the electronic device and the first network element.

In analogous field of endeavor, Gould discloses a system and method that employ wireless telecommunications technology and location information of a wireless device to locate and recover stolen vehicles or valuable objects (see abstract, col. 2, lines 45-51). According to Gould, a theft monitoring center may initiate a call to a theft detection device installed on a vehicle and request a position of the stolen vehicle to be determined wherein based on an established connection between the theft detection device and a base station of the wireless telephone network, and an MSC of the network forwards a location request to a location processor, which determines the location of position of the missing or stolen device or vehicle in terms of a street address from calculated geographical coordinates (see col. 2, lines 5-58, col. 7, line 51 to col. 8, line 13 and col. 10, lines ).



It would therefore have been obvious to one of ordinary skill in the art to provide Gould's location detection system with Grube in order to facilitate the quick recovery of lost or stolen precious properties of value as taught by Gould.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brown (6,819,258) discloses a personal tracking system that uses a web host connected to a wide area web network.

Ali et al. (5,588,005) discloses an asset tracking system.

Allen (3,618,059) discloses an electronic detection and tracing system.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**